

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GENBAND US LLC and
GENBAND MANAGEMENT SERVICES CORP.,
Petitioner,

v.

METASWITCH NETWORKS LTD.,
Patent Owner.

Case IPR2015-01457
Patent 8,687,640 B2

Before JAMESON LEE, JOSIAH C. COCKS, and
ROBERT L. KINDER, *Administrative Patent Judges*.

LEE, *Administrative Patent Judge*.

DECISION
On Request for Rehearing
37 C.F.R. § 42.71

Introduction

Petitioner requests rehearing of the Decision (“Dec.”) instituting review of claims 2–5, 15–18, and 22–24 but not claims 8–10 and 14 of the ’640 patent. Paper 11. Petitioner seeks to add claims 8–10 to the trial in this proceeding. The request is *granted*.

Discussion

Petitioner relied on Ejzak’s “local policy” as the “bypass mode data” of claim 8 which recites: “said bypass mode data indicating a bypass mode setting for said media gateway.” In the Decision, we stated: “The reference [in Ejzak] merely to ‘policy’ is unreasonably broad and not very meaningful when the limitation pertains to the bypass setting for a particular device.” Dec. 23. We questioned whether “local policy” that may apply generally to all media gateways indicates a specific bypass setting for a particular ALG, BG, or media gateway. *Id.* at 22. On that basis, we concluded that Petitioner failed to provide adequate explanation on how a “local policy” satisfies the bypass mode data requirement of claim 8. *Id.* at 23.

Petitioner identifies in its rehearing request points we misapprehended in our Decision. The Petition, as filed, adequately explains the “local policy” is specific to the local ALG. Reh. Req. 9–10. Petitioner identifies testimony of Mr. Bress, referred to in the Petition, that explain why one with ordinary skill in the art would understand “local policy” of Ejzak as local and specific to the ALG. *Id.* at 11 (citing ¶¶ 238–43 of Ex. 1104). We agree that on the record before us, “local policy” appears to be local to the ALG and not generally applicable to all media gateways.

Notwithstanding Patent Owner’s contrary arguments, Petitioner has made a sufficient showing with regard to claims 8 and 9. Petitioner explains

that based on the ALG's local policy, the ALG determines whether to bypass its own border gateway. Pet. 47. Indeed, Ejzak describes: "The ALG may then select one of the following four cases depending on applicability and local policy (at step 215) [Fig. 2]." Ex. 1103 ¶ 72. The four possible cases are: "1. Bypass the controlled BG and one or more prior BGs. 2. Bypass the controlled BG. 3. Bypass prior BGs. 4. Bypass no BGs." *Id.* The local policy leads the ALG to one of these four selections. Petitioner reasonably regards that the local policy indicates a bypass mode setting for the subject gateway.

Patent Owner argues that Ejzak does not describe how the local policy is stored or retrieved (Prelim. Resp. 27), but it is understood that the local policy has to be retrieved from somewhere, and claim 8 does not specify where the bypass mode data must be stored. Patent Owner argues that Ejzak's local policy does not indicate specifically what to do with the particular ALG or the BG that ALG controls, but only describes a general approach. Prelim. Resp. 28. The argument is unavailing, because even examples in the '640 patent, as identified by Patent Owner, of what constitutes bypass mode setting, includes an indication that is generic, i.e., "that the media gateway may be bypassed in the media path." Prelim. Resp. 28. The selectable results of Ejzak are no more general than a sample bypass mode setting in the '640 patent as identified by Patent Owner.

Petitioner also has presented a sufficient showing for claim 9. Pet. 47–49. Patent Owner asserts no separate argument with respect to claim 9. With respect to claim 10, however, Petitioner's showing is deficient. Claim 10 depends from claim 8, and further recites, in pertinent part: "further comprising determining from said bypass mode data that said media

gateway must be bypassed in said media path” We have reviewed Petitioner’s arguments on pages 49–51 of the Petition, and determine that Petitioner has made a sufficient showing with respect to claim 10 as well. Patent Owner argues that nothing has been presented by Petitioner that indicates it can be determined from the local policy in Ejzak that the pertinent gateway “must be bypassed.” Prelim. Resp. 29–31. The argument is unpersuasive. Although Ejzak does not use the specific word “must,” at least two of the four possible actions taken by the ALG based on the local policy include bypassing the pertinent gateway. Thus, at least for those selections the ALG does determine from the local policy that the gateway must be bypassed.

Order

It is

ORDERED that Petitioner’s Request for Rehearing is *granted*;
FURTHER ORDERED that we add the following grounds of unpatentability to the trial for this *inter partes* review:

1. Claims 8–10 under 35 U.S.C. § 103 as obvious over Ejzak and Intel; and
2. Claims 8–10 under 35 U.S.C. § 103 as obvious over Ejzak and Cisco.

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